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10/749,259

12/31/2003

James R. Butler

COS-890

8566

25264

7590

07/12/2007

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EXAMINER

MULCAHY, PETER D

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/749,259  
Filing Date: December 31, 2003  
Appellant(s): BUTLER ET AL.

**MAILED**  
**JUL 12 2007**  
**GROUP 1700**

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Shirley A. Kopecky  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal briefs filed December 22, 2006 and March 13, 2007  
appealing from the Office action mailed June 28, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

Claim 1 has been amended and claim 5 has been canceled subsequent to the final rejection.

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,713,539

Guo et al.

3-2004

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

Claims 1-3, 6-11, 13-20, 23, 24, 26, 28, 30-32, 35-37, 39-47, 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guo et al.

Table 4, Example 4 shows a method of preparing an asphalt and polymer composition comprising the process steps and the incorporation of zinc oxide. The zinc oxide used in the example is one of appellants preferred species of metal salt, see claim 3. The amount of zinc oxide used in the example is seen to anticipate the amount claimed. The compatibility limitation is presumed to be met by the method shown in the examples. Case law has well established that it is reasonable to presume that properties are anticipated or rendered obvious from the prior art teaching when the conditions and compositional ingredients are the same as those claimed. In the instant case, the compositional ingredients are the same and the mixing conditions are the same. It is reasonable to presume that the compatibility is improved as well. Applicants have failed to show or allege that such is not the case.

Appellants claim language "consisting essentially of" is intended to exclude the organic polar compound of the prior art. This language excludes ingredients that materially change the basic and novel characteristics of the claimed invention. It is not clear, and appellants have not identified, how the polar organic compound would

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materially change the basic and novel characteristics of the claimed invention. Further, the examiner maintains that the addition of a polar organic compound to the claimed invention would function in a similar manner to that of the prior art. In the event that the claims are interpreted so as to exclude the polar organic compound, then the claims are further obvious given that it is prima facie obvious to leave out an ingredient and lose its known function.

**(10) Response to Argument**

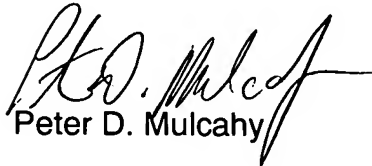
Appellants extensively argue that the art is silent as to the use of the metal salt to improve the compatibility of the asphalt and polymer. This is not persuasive. The art uses the same ingredients, mixing proportions and conditions. It is reasonable to presume that the same properties are obtained. There is no showing or allegation that the properties do not exist in the prior art. The fact that the art does not mention the use of the metal salt to improve compatibility is not germane to the patentability of the claims. Appellants cite the Perricone case to support the unobviousness of the claimed invention. This is not persuasive. This case is distinguishable from the instant claims. The court found that sunburned skin is materially different from skin which is not sunburned. Thus applying the lotion to skin which is sunburned is materially different from applying the lotion to skin which is not sunburned. Here, the systems are the same. There is no material difference between the asphalt/polymer compositions claimed and shown in the art. As such, it is reasonable to presume that the art possesses compatibility properties that either anticipate or render obvious those claimed.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

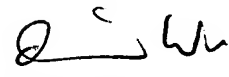


Peter D. Mulcahy

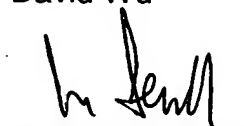
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AU 1713

Conferees:



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James Seidleck